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FOLEY & LARDNER
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In re Application of :
Morton Meldal et al :
Serial No.: 09/787,881 : PETITION DECISION
Filed: June 28, 2001 :
Attorney Docket No.: 030307-0196 :
:

This is in response to the petition under 37 CFR 1.144, filed May 13, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on June 28, 2001, and contained, as filed, claims 1-36, which were amended by preliminary amendment to claims 1-14, 28-32 and 34-36 and new claim 37 (incorrectly numbered as 34). In a first Office action, mailed October 1, 2004, the examiner set forth a Lack of Unity, as follows:

Group I, claims 1-4, 7-10 and 36, drawn to a macromonomer having a vinylphenylpropyl terminal group;

Group II, claims 1-3, 5-10 and 36-37 drawn to a macromonomer having an oxetane terminal group; and

Group III, claims 11-14, 28-32 and 34-35, drawn to a polymer.

The examiner reasoned that the groups lacked a common core structure essential to their utilities and are made by different processes and reactions.

Applicants replied on December 1, 2004, electing Group II, with traverse. Applicants argued that Groups II and III should be rejoined under PCT rules as they share a common core and inventive concept. Applicants also noted that the claims reviewed by the examiner were not the same as those at issue in the IPER. Applicants also provided a new set of amended claims.

The examiner mailed a new Office action to applicants on January 13, 2005, acknowledging applicants election and revising the restriction requirement to claims 1-9 and 33 in Group I and

claims 10-32 in Group II. The examiner noted the traverse, but found it unpersuasive. The examiner made the requirement Final. The examiner also rejected claim 1 under 35 U.S.C. 102(b) as anticipated by DE 1911328. Claims 2-9 and 33 were objected to as depending from a rejected claim.

Applicants replied on May 13, 2005 with an amendment and this petition.

DISCUSSION

Applicants argue in their petition that the claims, as now amended, relate to a monomer and the polymer made therefrom. Applicants argue that the polymer contains the same significant structural element that the monomer does and should therefore, be examined with the monomer in accordance with PCT Rule 13. A review of the claims shows that applicants' arguments are correct. The monomer and its preparation are encompassed by claims 2-9 and 34 and the polymer made from the monomer is encompassed by claims 11-14 and 28-32. The monomer is the intermediate used in preparing the final product and thus has unity with the final product. (See example 28 in Annex B of the Administrative PCT Instruction.) Thus all claims share a significant structural element or special technical feature and have Unity of Invention.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for consideration of the amendment filed May 13, 2005, and further prosecution not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



George C. Elliott
Director, Technology Center 1600